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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,820	02/27/2002	Chauncey W. Griswold	404980	8636

7590

12/08/2003

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EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 12/08/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,820

Applicant(s)

GRISWOLD, CHAUNCEY W.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003 and 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on July 11, 2003 and the reply to the non-responsive amendment filed on September 25, 2003 in which applicant amends claims 1, 9, and 27, cancels claim 15, adds claims 29 and 30, submits an information disclosure statement, and responds to the claim rejections.

Claim Objections

2. Claim 5 is objected to because of the following informalities:

- In claim 5, line 1, the indefinite article “an” should be placed before the first instance of the subject “apparatus” in the claim.

Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-9, 11-14, 16-20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,110,041) in view of Orus et al. (U.S. Patent Application Publication 2002/0047044 A1).

Walker et al. discloses a method and system for adapting gaming devices to a player's playing preferences. In particular, a gaming machine is networked to a central server which receives preference data from a player and configures the gaming machine to match the received preference data. The player inserts an electronic player tracking card (and/or other "biometric" data is used) to authenticate that a particular player is on a machine by transmitting data to a central server. Once this data is authenticated the central server programs or configures the gaming machine to the player's preferences. Walker et al. additionally discloses:

Regarding Claims 1 and 9:

- displaying to the gaming machine a card carried by the player, said card comprising suitable electronics/indicia, causing transfer of first individualized data concerning the player from the card to the gaming machine or to a computer network associated with the gaming machine (Abstract, Figs. 1-11B, Column 2, lines 13-53, Column 3, lines 46-54, Column 4, lines 6-64, and Column 9, lines 35-37);
- evaluating the data against a stored database, and activating said gaming machine for said subsequent play upon favorable evaluation of said data, and, during or after said subsequent play, causing the transfer of second, individualized data back to the card to be stored (Abstract, Figs. 1-11B, Column 2, lines 13-53, Column 3, lines 46-54, Column 4, lines 6-64, and Column 9, lines 35-37) .

Regarding Claims 2 and 12:

- the player also physically actuates the gaming machine as a separate, added step to activate the machine (Column 6, lines 11-13).

Regarding Claims 3 and 13:

- the player moves the card in closely spaced relation to a sensor on said gaming machine to display said card to the gaming machine (Fig. 3 (364), and Column 6, lines 39-61).

Regarding Claims 4 and 14:

- the player provides a separate, personal identification to the gaming machine in the form of letters or numbers as a necessary prerequisite to said machine activation (Column 6, lines 47-49).

Regarding Claims 5 and 9:

- apparatus for biometric scanning provides a biometric scan of said player as a necessary prerequisite to said machine activation (Column 6, lines 39-61).

Regarding Claims 6 and 16:

- after evaluation of said data, the gaming machine is activated in a specific mode selected from a plurality of possible modes of activation, the specific mode being a function of the individualized data (Abstract, Figs. 1-11B, Column 2, lines 13-53, Column 3, lines 46-54, Column 4, lines 6-64, and Column 9, lines 35-37).

Regarding Claims 7 and 17:

- the specific mode selected comprises a particular game or choice of games to be played (Figure 5).

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Regarding Claims 8 and 18:

- the specific mode selected comprises a special offer of a benefit or activity for the player (Figure 5).

Regarding Claim 11:

- the indicia on said card are indicia comprising members for magnetic sensing by apparatus associated with the gaming machine (Column 6, lines 41-43).

Although Walker et al. discloses a player tracking card and tracking card reader which deposits/withdraws virtual cash or credits to/from a player tracking card based upon a players winnings/losings, Walker et al. seems to lack explicitly disclosing:

Regarding Claims 1 and 9:

- a contactless player tracking card having electronics and an antenna causing a wireless transfer of player data to a gaming machine or computer network.

Regarding Claim 26:

- microprocessor providing a plurality of separate accounts to the user.

Orus et al. does not teach transmitting player preference data to a slot machine based on identification data read from a player tracking card. Instead, Orus et al. teaches of a system and method for securely transferring, via bi-directional wireless communication, bets and winnings to/from contactless gambling cards and slot machine/slot machine networks based on identification data read from a player tracking card. Orus additionally teaches:

Regarding Claims 1 and 9:

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- a contactless player tracking card having electronics and an antenna causing a wireless transfer of player data to a gaming machine or computer network (Paragraphs 2, 14-16, 18, and 33).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to modify Walker's gaming machine with Orus' contactless gaming card system. One would be motivated to do so because this would provide a secure data exchange over a network, wherein a security module calculates an authentication certificate from secret data stored on the memory of the contactless gambling card and the monitoring means checks the authentication certificate calculated by the security module corresponding to the authentication certificate calculated by the contactless gambling card.

Regarding Claim 26, it would have been obvious to one having ordinary skill in the art, at the time of applicant's invention, to provide access to a plurality of separate accounts for a player with a single contactless gambling card. That is, individual accounts for slot machines, poker machines, and other gaming machines. Otherwise, players would have to use multiple contactless gambling cards in a casino to play a variety of games which would totally defeat the purpose of having a contactless gambling card in the first place.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,110,041) in view of Orus et al. (U.S. Patent Application Publication 2002/0047044 A1) and further in view of Franchi (U.S. 5,770,533).

Walker et al. in view of Orus et al. discloses that as discussed above regarding claims 1-9, 11-14, 16-20, and 26. However, Walker et al. in view of Orus et al. seems to lack explicitly stating:

Regarding Claim 10:

- the indicia on the card are optical indicia.

Franchi teaches of an open architecture casino operating system for monitoring game play and the flow of funds in a casino. Each player receives an embedded betting card having a microprocessor and memory for preserving identification, cash balance, and identification code of the player. Furthermore, Franchi teaches:

Regarding Claim 10:

- the indicia on the card are optical indicia (Column 2, lines 38-54).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to use optical indicia capability of Franchi in the combination of Walker et al. in view of Orus et al. One would be motivated to do so because optical indicia, like those used for bar-code readers, were well known at the time of Applicant's invention and would enable a player having a contactless gambling card to play a game on a gaming platform that has not been updated to the latest contactless gambling card technology.

7. Claims 21-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,110,041) in view of Orus et al. (U.S. Patent Application Publication 2002/0047044 A1) and further in view of (Philips Semiconductors - Leading-edge smart card technology meets smartest watch technology - Press release) (Philips Semiconductors).

Walker et al. in view of Orus et al. discloses that as discussed above regarding claims 1-9, 11-14, 16-20, and 26. However, Walker et al. in view of Orus et al. seems to lack explicitly stating:

Regarding Claim 21:

- the card is carried by the player in the form of an article of personal adornment or clothing.

Regarding Claim 22:

- the card is carried by the player in the form of a wristwatch.

Regarding Claim 27:

- an article of personal adornment or clothing which carries suitable electronics and an antenna to permit the two way wireless transfer of individualized data concerning the wearer of said article between the electronics and a gaming machine or a computer network that is associated with the gaming machine.

Regarding Claim 28:

- the article is in the form of a wristwatch.

Regarding Claim 29:

- the individualized data transferred from the gaming machine to the computer network from the electronics of said article comprises virtual cash added or subtracted from an electronic cash balance carried in said electronics.

Regarding Claim 30:

- the personal adornment comprises a non-timekeeping bracelet, a necklace, a belt buckle, or a hat.

Philips Semiconductors teaches of a contactless smart card controller IC incorporated into a watch. The watch can support multiple communications protocols and have endless applications for personal identification and storing personal data. Philips Semiconductors teaches:

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Regarding Claim 21:

- the card is carried by the player in the form of an article of personal adornment or clothing (pp. 1-3).

Regarding Claim 22:

- the card is carried by the player in the form of a wristwatch (pp. 1-3).

Regarding Claim 27:

- an article of personal adornment or clothing which carries suitable electronics and an antenna to permit the wireless transfer of individualized data concerning the wearer from the electronics to a gaming machine or to a computer network that is associated with the gaming machine (pp. 1-3).

Regarding Claim 28:

- the article is in the form of a wristwatch (pp. 1-3).

Regarding Claim 29:

- the individualized two way wireless data transferred from the gaming machine to the computer network from the electronics of said article comprises virtual cash added or subtracted from an electronic cash balance carried in said electronics (pp. 1-3).

Regarding Claim 30:

- the personal adornment comprises a non-timekeeping bracelet, a necklace, a belt buckle, or a hat. Although the technology taught by Philips Semiconductor is implemented in a watch, it would have been obvious to one having ordinary skill in the art to implement the contactless smart card technology in a bracelet or other

personal adornment such that a player can have access to a gaming machine with both hands at all times.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Philips Semiconductor watch technology in Walker et al. in view of Orus et al. One would be motivated to do so because Philips Semiconductors watch technology provides a highly attractive and convenient carrier for the smart card technology enabling a player access to a gaming machine with both hands at all times.

Response to Arguments

8. Applicant's arguments filed on July 11, 2003 and September 25, 2003 have been fully considered but they are not persuasive.

9. Applicant disagrees with the rejection to claims 1-9, 11-14, 16-20, and 26 under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. 6,110,041) in view of Orus et al. (U.S. Patent Application Publication 2002/0047044 A1). Applicant alleges it would not have been obvious to one having ordinary skill in the art to make the combination of Walker et al. and Orus et al. because Walker et al. teaches a player tracking card that must be inserted into a gaming machine, and therefore, teaches away from the contactless card. The examiner respectfully disagrees. Walker et al., like Orus et al. requires a way to identify players, player's data, and account information such that players can play gaming machines without cash or coins. Furthermore, Orus et al. allows for a contactless card type gambling system which enables a player to wager/play a game by transmitting data to/from the contactless card without making a physical electrical contact such as is required with a physical card having a magnetic strip that is inserted into gaming machines and read by a card reader. Therefore, it would have been obvious

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to one having ordinary skill in the art at the time of Applicant's invention to modify Walker's gaming machine with Orus' contactless gaming card system. One would be motivated to do so because this would provide a secure data exchange over a network, wherein a security module calculates an authentication certificate from secret data stored on the memory of the contactless gambling card and the monitoring means checks the authentication certificate calculated by the security module corresponding to the authentication certificate calculated by the contactless gambling card.

10. Applicant indicates claim 1 has been amended to require the step, "...during or after said subsequent play, causing wireless transfer of second, individualized data back to the card to be stored." Applicant alleges Walker et al. does not teach this feature. However, the examiner does not rely on Walker et al. to teach such wireless transfer, but relies on Orus et al. to teach this feature. Therefore, the examiner believes in this case, the references, if taken as a whole, render the instant invention obvious.

11. Regarding claims 5 and 9, Applicant alleges Walker et al. fails to teach, "a biometric scan of said player as a necessary prerequisite to said machine activation," and that this biometric feature is "contemplated as a substitute for the player card rather than an addition to the contactless method of claim 1." Although Walker et al. states, "A slot machine (120) recognizes the identity of players through player identification devices other than player card tracking device (360), thereby eliminating the need for players to carry player identification cards." (Column 6, lines 53-56), the passage taken as a whole (Column 6, lines 39-61) does not preclude the use of a player identification tracking card with biometrics in Walker's system. In particular, the passage discloses how redundant or multiple other inputs other than the identification number

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read off the magnetic strip of the player identification tracking cards, such as pin codes or biometrics (finger print, voice, or retinal) are used to securely identify players. Therefore, the examiner believes this feature is disclosed in Walker et al.

12. Regarding claims 10-26, Applicant alleges the claims are allowable because they are dependant upon claim 9. However, the examiner disagrees. Please see the arguments presented in item No.'s 9, 10, and 11 above.

13. Regarding claim 27, Applicant alleges the claim is allowable for similar reasons as discussed with respect to Walker et al. However, the examiner disagrees. Please see the arguments presented in item No.'s 9, 10, and 11 above.

14. Applicant's arguments, see pages 1 and 2 of the response, filed September 25, 2003, with respect to the rejection to claim 5 under 35 U.S.C. 112, second paragraph has been fully considered and is persuasive. The rejection of claim 5 under 35 U.S.C. 112, second paragraph has been withdrawn. However, the examiner has objected to the claim. Please see item No. 2.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ
sej



**MICHAEL O'NEILL
PRIMARY EXAMINER**